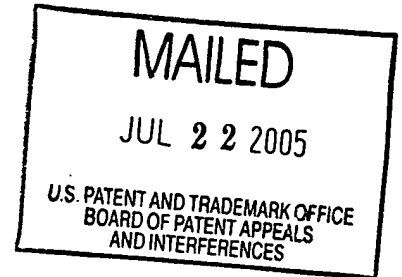


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DIETER WENNINGER,
STEFAN ROBER
WOLFGANG DAVID
and RALF SCHLIEPHACKE



Appeal No. 2005-1472
Application No. 09/750,984

ON BRIEF

Before GARRIS, KRATZ and PAWLIKOWSKI, Administrative Patent Judges.
KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-13, which are all of the claims pending in this application.

BACKGROUND

Appellants' invention relates to an adhesive tape and a method of using such a tape for detecting unauthorized broaching of a package. The tape includes an oriented, co-extruded, multi-layer polypropylene film composite backing wherein one side of the film is coated with an adhesive layer that has a bond strength greater than the cleavage strength of the composite backing. Exemplary claims 1 and 10 are reproduced below.

1. An adhesive tape comprising a composite backing based on an oriented, coextruded, at least two-layer polypropylene film whose one side is provided with an adhesive layer wherein the cleavage strength of the composite backing is less than the bond strength of the adhesive.

10. A method for detecting unauthorized broaching of a package, which comprises sealing said package with the adhesive tape of Claim 1, wherein when the adhesive tape is removed from the surface of a package the adhesive tape is irreversibly destroyed and indicates an attempted broaching by tearing or splitting in the thickness direction.

In addition to alleged admitted prior art, the prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Freedman 5,876,816 Mar. 02, 1999

Allegre FR 2 749 316 Dec. 05, 1997¹

Claims 1-9 and 11-13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over alleged admissions at page 3, lines 10-17 and page 6, lines 9-12 of appellants' specification with or without the additional teachings of Allegre. Claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Freedman taken in view of the alleged admissions at page 3, lines 10-17 of appellants' specification.

We refer to the brief and to the answer for a complete exposition of the opposing viewpoints expressed by appellants and the examiner concerning the issues before us on this appeal.

OPINION

Upon careful review of the entire record including the respective positions advanced by appellants and the examiner with respect to the rejections before us, we find ourselves in agreement with appellants' viewpoint since the examiner has failed to carry the burden of establishing that the claimed

¹ Our references to Allegre in this decision are to the English language translation of the French patent publication by the Ralph McElroy Translation Company dated May 2003 that is of record in the electronic image file wrapper record.

subject matter would have been obvious within the meaning of 35 U.S.C. § 103 on this record. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1471-1472, 223 USPQ 785, 787-788 (Fed. Cir. 1984).

In both of the rejections advanced by the examiner, the examiner relies on alleged admitted prior art for the asserted teaching or suggestion of the tape construction as specified in claim 1.² As evident by a review of page 9 of the brief, a fundamental flaw in both of the examiner's rejections is made manifest by the examiner's continued reliance on all of the material presented at page 3, lines 10-17 of appellants' specification as admitted prior art. In this regard, appellants (brief, page 9) have unmistakably refuted the examiner's position that the entirety of the portion of the specification referred to by the examiner represents an admission of prior art. In

² In the rejection of product claims 1-9 and 11-13, the applied Alegre reference is relied upon by the examiner for evidencing the use of a notch (serration) feature, a matter the examiner acknowledges as only being relevant to the subject matter of dependent claim 3 wherein a serrated cut edge is recited. See, e.g., the sentence bridging pages 3 and 4 and the sentence bridging pages 4 and 5 of the answer. Regarding the examiner's rejection of method claim 10, the examiner (answer, page 7) states that "it is the admission, not the Freedman disclosure, that the Examiner is relying upon to disclose the "key limitation" that "it is accomplished with the adhesive tape of claim 1."

particular, appellants place a clear limit as to the scope of admission of previously known facts at page 3, lines 10-17 of their specification to the following sentence as reproduced at page 9 of the brief:

Thus, it is known that films comprising non-heat-sealable, coextruded, high crystalline polypropylene layers exhibit a weak bond of the film layers to one another.

The examiner's use of other portions of appellants' specification at page 3 as representing alleged admitted prior art in the rejections laid before us for review in the answer in the face of appellants clear disputation of such additional admissions is untenable and represents reversible error.

We are not unmindful of the examiner's alternative obviousness position at page 7 of the answer wherein the examiner asserts a belief that even if the specification admission is limited as appellants do indeed so limit it, that admission of facts "would give one of ordinary skill in the art in this technically sophisticated field more than enough information to reduce the claimed invention to practice." This is so, according to the examiner (answer, page 7), because:

polypropylene backings using various polypropylene based compositions and their resultant behavior as backings are well-known, and it is also firmly believed that to adjust the cleavage strength of the various

polypropylene layers when one is aware that certain polypropylene layers exhibit weak bonds of the film layers to one another is also well within the skill of the art, as is to adapt this parameter to the bond strength of the adhesive layer on the backing to whatever value is desired.

The difficulty we have with that alternatively stated position of the examiner and the rejections premised thereon is that the examiner has not supported that presentation of propositions based on "belief" with adequate evidence that is appropriately referenced and of sufficient weight to document the examiner's statements as to what is within the skill of the art and well known.

A determination of obviousness must be based on supported facts, not on unsupported generalities. See In re Freed, 425 F.2d 785, 165 USPQ 570, 572 (CCPA 1970); In re Warner, 379 F.2d 1011, 154 USPQ 173, 177-178 (CCPA 1967). The mere fact that the prior art could be modified as proposed by the examiner is not sufficient to establish a prima facie case of obviousness. See In re Fritsch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992).

Without such properly referenced supporting evidence to establish that the claimed subject matter would have been reasonably suggested to one of ordinary skill in the art at the

time of the invention with a reasonable expectation of success in so doing, it appears that the rejection before us is premised on impermissible hindsight arrived at through a reading of appellants' specification including the portions thereof not acknowledged as admitted prior art by appellants. See W.L. Gore & Associates v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983); In re Rothermel, 276 F.2d 393, 396, 125 USPQ 328, 331 (CCPA 1960).

For the above reasons, we find that the examiner has not set forth and appropriately developed a factual basis which is sufficient to support a conclusion of obviousness of the invention recited in any of appellants' claims.

The decision of the examiner to reject claims 1-9 and 11-13 under 35 U.S.C. § 103(a) as being unpatentable over alleged admissions at page 3, lines 10-17 and page 6, lines 9-12 of appellants' specification with or without the additional teachings of Allegre and to reject claim 10 under 35 U.S.C. § 103(a) as being unpatentable over Freedman taken in view of the alleged admissions at page 3, lines 10-17 of appellants' specification is reversed.

BRADLEY R. GARRIS

Peter F. Kratz

BOARD OF PATENT
APPEALS
AND
INTERFERENCES

Beverly A. Lawrence

BEVERLY A. PAWLIKOWSKI
Administrative Patent Judge

PFK/sld

Appeal No. 2005-1472
Application No. 09/750,984

Page 9

NORRIS MCLAUGHLIN & MARCUS, P.A.
220 EAST 42ND STREET
30TH FLOOR
NEW YORK, NY 10017